

**REMARKS/ARGUMENTS**

In the Office Action, the Examiner noted that claims 1-20 are pending in the application and that claims 1-20 are rejected. By this response, claims 1, 8-9, and 17-18 have been amended. Thus, claims 1-20 remain pending in this application.

**Claim Objections**

The Examiner has objected to claim 4 under 37 CFR 1.75 as being a substantial duplication of claim 1. Applicant respectfully disagrees with the Examiner. Claim 4 is not a substantial duplicate of claim 1. There exists more than a slight difference in wording between claims 1 and 4. More particularly, claim 4 includes the limitation of, "...the computer peripheral device comprises an embedded web server...". This limitation clearly narrows independent claim 1 and is more than a slight difference in wording between claims 1 and 4. Applicant respectfully requests reconsideration with respect to the objection to claim 4 under 37 CFR 1.75.

Claims 8, 9, 17, and 18 are objected to by the Examiner because the claims recite the limitation "the embedded web server", and there is insufficient antecedent basis for this limitation in the claims. Claims 8-9 and 17-18 have been amended to overcome the lack of antecedent basis. Accordingly, the objection is believed to be overcome.

**Rejections Under 35 U.S.C. §112**

Claims 1-11 and 18 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement.

As illustrated in Figure 1 and described at page 7, lines 9-29, computer peripheral device 16 includes an embedded web server 17 along with a messaging system 46 comprising an e-mail application program 48 (see also, page 5, lines 28-31). As shown in Figure 2 (as well as page 7, lines 12-29), embedded web server 17 includes a purchasing tool 64. A customer at PC 14 receives an e-mail supplies out alert 52 from computer peripheral device 16 by way of embedded web server 17, indicating the status of consumable supplies

within device 16. For example, an alert 52 alerts the consumer that a supply of toner is out (or nearly out) at device 16.

It is well known to one of ordinary skill in the field that an embedded web server comprises web server software that is embedded within a hardware device such as a print server. The embedded web server is widely used in a myriad of devices, because it allows access to software by way of any web browser, typically in order to configure a device or obtain reports (*Computer Desktop Encyclopedia*, 9<sup>th</sup> ed., Alan Friedman; Osborn/McGraw-Hill, ©2001).

In order to establish a *prima facie* case of non-enablement with respect to the disclosure of a patent application, the Examiner must provide: 1) a rational basis as to a) why the disclosure does not teach or b) why to doubt the objective truth of the statements in the disclosure that purport to teach; 2) the manner and process of making and using the invention; 3) that corresponds in scope to the claimed invention; 4) to one of ordinary skill in the pertinent technology; 5) without undue experimentation; and 6) dealing with subject matter that would not already be known to the skilled person as of the filing date of the application.

In order for a rejection under first paragraph of Section 112 to be proper, the Examiner must provide evidence from the application supporting each of these elements. It is well established that the applicant need not disclose every minute detail for an application to be enabling. In fact, the drawings alone may be sufficient for enablement. If the drawings in conjunction with the rest of the specification enable a person skilled in the art to make a selection and practice the claimed invention with only a reasonable degree of routine experimentation, then enablement has been established. The specification need not recite details of the claims where one of ordinary skill in the art would consider these details obvious. An embedded web server in a computer peripheral device is taught to sufficient scope for one of ordinary skill in the pertinent technology (without undue experimentation).

Furthermore, when an invention involves multiple technologies, enablement is judged from the view of a person of ordinary skill in each separate technology. When an invention is more complicated because of the combination

of separate technologies, an Examiner may not assert that the application must include a more detailed explanation of how to make and use it (see *In re Naquin*, 398 F.2d 863, 158 USPQ 317 (C.C.P.A. 1968)).

The specification need not describe or enable the invention to a layperson. Rather, it need only describe the invention to one of ordinary skill in the art. "Requiring inclusion in the patent of known scientific/technological information would add an imprecise and open-ended criterion to the content of patent specifications, could greatly enlarge the content of patent specifications and unnecessarily increase the cost of preparing and prosecuting patent applications, and could tend to obfuscate rather than highlight the contribution to which the patent is directed. A patent is not a scientific treatise, but a document that presumes a readership skilled in the field of the invention." See *Ajinomoto Co., Inc. v. Archer-Daniels-Midland Co.*, 228 F.3d 1338, 56 USPQ2d 1332, 136 (Fed. Cir. 2000), *cert. denied*, 532 U.S. 1019 (2001) (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1556, 220 USPQ 303, 315 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984)).

Whether an invention requires undue experimentation is based on many factors including the quantity of experimentation necessary, the nature of the invention, the state of the prior art, the relative skill of those in the art, etc.

Applicant asserts that claims 1-11 and 18 comply with the enablement requirement and that rejection under 35 U.S.C. § 112, first paragraph, is overcome. Action to that end is respectfully requested.

Claims 1-11 and 18 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Examiner previously asserted, by way of the 35 U.S.C. § 112, first paragraph, rejection above, claims 1, 3 and 18 are not enabling. The Examiner has then asserted that it is unclear to the Examiner how the reseller and the manufacturer web servers are able to communicate directly with the peripheral device. The Examiner has then stated, for examination purposes, the Examiner has assumed that all communication occurs via the personal computer since the personal computer is the only device that is capable of communicating directly with the peripheral device and the reseller/manufacture web servers.

Independent claim has been amended to include "...via the personal computer...". Accordingly, the second paragraph, 35 U.S.C. § 112, rejections to claims 1-12 and 18 are believed to be overcome. Claims 1-12 and 18 are believed to be allowable, and action to that end is respectfully requested.

**Rejections Under 35 U.S.C. §103**

Claims 1-4, 8-10, 12, 13, and 19 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268).

Claims 5 and 11 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268) and further in view of *Hartman, et al.* (U.S. Patent No. 5,960,411).

Claim 7 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268) and further in view of Official Notice.

Claim 6 is rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268) and further in view of *Hartman, et al.* (U.S. Patent No. 5,960,411) and *Kageyama* (U.S. Patent No. 6,333,790 B1).

Claims 14-18 and 20 are rejected under 35 U.S.C. §103(a) as being unpatentable over *Istvan* (U.S. 2002/0042747 A1) in view of *Yoda* (U.S. Patent 5,515,268) and further in view of *Kageyama* (U.S. Patent No. 6,333,790 B1) and Official Notice.

With respect to the obviousness rejection of claims 1-3, 12, 13 and 19, the Examiner asserts that *Istvan* (U.S. 2002/0042747 A1) teaches a computer peripheral device having a messaging system communicating with a personal computer. The Examiner then asserts that *Istvan* does not teach a reseller web server having a messaging system communicating with a personal computer and configured to capture customer preferences from a customer accessing the reseller web server to order consumables via the computer peripheral device. The Examiner then states that *Istvan* teaches that a user may order ink refill products via the communication device by shopping online. The Examiner next asserts that it would have been obvious to one of ordinary skill in

the art at the time the invention was made to have the online merchant in the invention of *Istvan* to be a reseller. The Examiner claims that one of ordinary skill in the art would have been motivated to do so in order to have the user visit a web site that had the item the user was interested in buying. As stated by the Examiner, *Istvan* does not teach that the online merchant captures customer preferences. The Examiner then cites *Yoda* (U.S. Patent 5,515,268) for teaching an apparatus for computer-assisted shopping wherein a remote vendor system captures a user's personal preferences. The Examiner then states it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of *Yoda* into the apparatus of *Istvan*. One of ordinary skill in the art would be motivated to do so in order to provide quicker and better services to customers as taught by *Yoda*. As also stated by the Examiner, *Istvan* and *Yoda* do not teach that a device-manufacturer web server communicates with the reseller web server and receives customer preferences from the reseller web server. The Examiner then states that it would have been obvious to one of ordinary skill in the art to do this and that one of ordinary skill in the art would have been motivated to do so in order to allow the reseller or the manufacturer to have business-to-business relationships.

Applicant respectfully disagrees with the Examiner's assertion. There is no teaching or suggestion to combine or modify *Istvan* and *Yoda* for such stated purpose. Furthermore, *Istvan* merely teaches that a user may order ink refill products by performing online shopping. This is vastly different than the claimed recitation of independent claims 1, 12, and 19. By way of example, independent claim 1 has a computer peripheral device with a messaging system that communicates with a personal computer. The device-manufacturer website communicates with the reseller web server and the computer peripheral device. The device-manufacturer web server is operative to receive customer preferences from the reseller web server and forward the customer preferences to the computer peripheral device using a messaging address for the computer peripheral device. Nowhere is this limitation taught or suggested by *Istvan* in combination with *Yoda*.

In order to establish a *prima facie* case of obviousness, the Examiner must provide: 1) one or more references; 2) that were available to the inventor and; 3) that teach; 4) a suggestion to combine or modify the references; 5) the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art. Here, the Examiner has failed to establish all of the elements. The Examiner has not shown a case of *prima facie* obviousness pursuant to the arguments presented above. Accordingly, Applicant asserts that obviousness rejection of claims 1-20 has been overcome.

Withdrawal of these rejections is respectfully requested.

### CONCLUSION

For all the reasons advanced above, Applicant respectfully submits that the application is in condition for allowance, and action to that end is respectfully requested. If the Examiner's next anticipated action is to be anything other than a Notice of Allowance, the undersigned respectfully requests a telephone interview before issuance of any such subsequent action.

Respectfully submitted,

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